

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-32 are presented for examination. Claims 1-29, 31, and 32 have been amended to emphasize existing claim requirements relative to the previously claimed game executing device that had to be configured as a game controller without “storage means for storing game software.” Further note the description of the “game machine,” the “STB (Set Top Box), and the “Television Receiver (Display Device) at pages 20-33 and the “Operation of the Game Machine” at pages 33-45 as to the first embodiment, for example.

The outstanding Office Action presents a rejection of Claims 1-8 and 14-32 under 35 U.S.C. §101, a rejection of Claims 1-8 and 14-32 under the written description requirement of first paragraph of 35 U.S.C. §112, a rejection of Claims 1-8 and 14-32 under the enablement requirement of first paragraph of 35 U.S.C. § 112, rejections of Claims 1-8 and 14-32 and 1-32 under the second paragraph of 35 U.S.C. § 112, a rejection of Claims 1-32 under 35 U.S.C. §103(a) as being unpatentable over Crawford (U.S. Patent No. 5,771,354) in view of Schindler et al (U.S. Patent No. 5,675,390, Schindler).

It is believed that In re Donaldson Co., 16 F.3d 1189, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) establishes it to be clear error to determine “the broadest reasonable interpretation” of “means-plus-function language” without considering “the structure disclosed in the specification corresponding to such [means-plus-function] language,” as was done in the outstanding Action. in order advance prosecution, the nature of the previously claimed “storage means for storing game software” has been made unmistakable as not being a ROM, RAM, or

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register because it must be a “drive storage means” or a “means for storing game software on a driven storage medium.” This terminology is fully supported by the exemplary disclosure of page 18, line 15-page 19, line 17 of the specification.

In addition, Claims 1-29, 31, and 32 have been amended to give emphasis to the exterior nature of the digital communication line and to insure that the clarified “means” for receiving a digital television broadcast signal and the similar step of the method claims are treated as positive claim limitations in accordance with established case law.

Turning to the outstanding rejections of Claims 1-8 and 14-32 under 35 U.S.C. §101, it is noted that this rejection appears to be predicated on a mistaken interpretation of the subject matter of Claims 1-8 and 14-32 as reciting that no type of memory components storing any type of software can be present in the claimed “game executing device” that recited inclusion of “a game controller” that had to be “without storage means for storing game software” (emphasis added).

The present amendment clarifies that the previously recited “storage means” of Claim 1 is a “means for storing game software on a driven storage medium.” The other independent claims now recite a “drive storage means” that clearly cannot be interpreted to include devices like the ROM, RAM and process registers noted in the outstanding Action. Further note the Donaldson precedent cited above and its holding that means-plus-function language can only be properly interpreted in light of “the structure disclosed in the specification corresponding to such [means-plus-function] language.”

Accordingly, withdrawal of the rejection of Claims 1-8 and 14-32 under 35 U.S.C. §101 as lacking “utility” is believed to be in order.

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Similarly, the rejections of Claims 1-8 and 14-32 under the written description and enablement clauses of the first paragraph of 35 U.S.C. §112 is predicated on the above noted interpretation of Claims 1-8 and 14-32 as reciting no RAM, ROM, disk drives, process registers, etc.” Once again, it is noted that a “drive storage means” or a “means for storing... on a driven storage medium” does not include devices like the ROM, RAM and process registers noted in the outstanding Action, and that the above-noted Donaldson precedent must be followed in interpreting these claimed “means.”

Accordingly, withdrawal of these rejections of Claims 1-8 and 14-32 under the enablement and written description requirements of the first paragraph of 35 U.S.C. §112 is also believed to be in order.

With further regard to the rejections of Claims 1-8 and 14-32 and 1-32 under the second paragraph of 35 U.S.C. § 112, these rejections are traversed as they incorrectly attempt to equate broad claim language with indefiniteness.

In this regard, the fact that a claim term is broad enough to cover any known “storage means” or any known “drive means” does not make the claim language indefinite as it is well established that “breadth is not to be equated with indefiniteness.” See In re Miller, 169 USPQ 597, 600 (CCPA 1971). Further in this regard, the Miller Court noted (at 169 USPQ 599) that as long as “those skilled in the art can tell whether any particular [subject matter] is or is not within the scope of a claim, the claim fulfills its purpose as a definition.” Accordingly, as it is clear what would or would not be included in the scope of rejected Claims 1-32, these rejections are clearly in error and should be withdrawn.

Turning to the outstanding rejection of Claims 1-32 as being unpatentable over Crawford in view of Schindler, it is noted that the actual limitations of independent base Claims 1, 9, 14, 19, and 23 have once again not been properly considered in clear violation of established precedent cited in the last response (see again In re Wilson, 165 USPQ 494, 496 (CCPA 1970) requiring that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art”).

The sentence bridging pages 5 and 6 of the outstanding Action notes that communications lines 150 of Crawford are external to “the server device, display device, and the game executing device.” However, the claims require more of the claimed digital communication line as it must also connect the STB device, the display device, and the game executing device to each other, while remaining completely external of these connected devices.

In this regard, page 4 of the outstanding Action has stated that it is interpreting the game executing device as being the CPU 68 of the computer 52 (actually called the main processing unit 52 by Crawford), which are elements of each customer computer 50 of Crawford. The whole of one such customer computer 50 (50(Z)) is then said to be reasonably readable as the “set box top” (STB) being claimed. The claimed display device is then equated to the display 54 of Crawford that is also part of each customer computer 50 as are the other common elements shown inside the dotted line labeled “50” in FIG. 3.

Putting aside for the moment the unreasonableness of these interpretations of the claimed subject matter as reading on these components of Crawford, it is clear that these components cannot be said to be “connected to each other” by the data link 150 of Crawford as each of the rejected claims recites expressly or by virtue of claim dependency.

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Thus, while data link 150 of Crawford can be said to be external to customer computer 50(Z), CPU 68, and display 54, it cannot be reasonably said to connect customer computer 50(Z), CPU 68, and display 54 to each other in any way. While an internal bus could be assumed to exist that would interconnect the processing units 68 and the Monitor 54, such an internal bus cannot be said to be external to any computer 50, like computer 50(Z) said to be read as the STB, for example.

To even more clearly demonstrate the inadequacy of the present rejection, the claims expressly or by virtue of dependency now all recite that the fact that the digital communication line that connects the STB device, the display device, and the game executing device to each other must be completely external “to each of the STB device, the display device, and the game executing device.” Accordingly, attempts to read any internal bus segment as part of the claimed digital communication line that connects the STB device, the display device, and the game executing device to each other, as attempted in paragraph 8 on page 4 of the Action mailed July 12, 2004, are also clearly without merit.

Besides not considering all the digital communication line limitations of rejected Claims 1-32, the outstanding obviousness rejection makes no attempt to accurately determine the subject matter of any of the independent or dependent claims, much less any attempt to accurately determine the differences between this claimed subject matter and the teachings actually presented by Crawford and Schindler. Thus, the PTO has failed to carry its burden of establishing a *prima facie* case of obviousness as this burden requires the PTO to begin by properly ascertaining the differences between the prior art and the claims at issue. See Graham v. John Deere Co., 383 U.S. 1, 17 (1966).

In this last regard, independent base Claim 1 recites, *inter alia*, “[a] game machine system comprising a set top box (STB) including means for receiving a digital television satellite broadcast signal and for supplying television program data corresponding to the received digital television satellite broadcast signal to a display device” (emphasis added).

Similar recitals and similar requirements as to method steps appear in the other independent claims, and thus are included in the dependent claims by virtue of such dependency.

In addition, the outstanding Action incorrectly asserts that a STB “is merely a computer that is associated with the cable TV system” followed by an observation that “FIG. 4 shows computer [sic, 50(Z)] attached to the disclosed communication system via a cable TV connection (134).” However, the above-noted claimed requirement for the STB to receive a digital TV satellite broadcast signal and to supply TV program data corresponding thereto to a display device goes far beyond a computer merely “associated with the cable TV system.”

Further in this regard, previous rebuttal by the PTO (at page 2 of the Action mailed July 12, 2004), makes it clear that the PTO is making unwarranted assumptions that “a set-top-box is nothing more than a computer” simply because a computer and the “set-box-top” **OF THIS APPLICATION** have **SOME** common elements in terms of a processor, input means and output means.

First of all, the components necessary to have a functional set-top-box (STB) are those indicated by Schindler at col. 2, lines 15-21, that notes that STB devices include components permitting them to act as integrated receivers/decoders, with absolutely no mention of using any computer components, such as a processor. What the PTO has done is to attempt to use Applicants’ preferred embodiment of FIG. 4 that illustrates part of Applicants’ invention as

including an STB device combining traditional STB components with computer components as if it were a prior art showing or evidence that all STB devices include these computer components. This approach is improper. See In re Sponnoble, 160 USPQ 237 (CCPA 1969) noting that “[t]he issue, then, is whether the teachings of the prior art would, *in and of themselves and without the benefits of appellant's disclosure*, make the invention as a whole, obvious.” Thus, the reliance on Applicants’ preferred embodiment as if it were prior art that can be offered as proof of obviousness is improper.

Second, the STB illustrated by Applicants’ FIG. 4 is clearly associated with a TV satellite receiver 21, not a cable TV system as erroneously alleged in the July 12, 2004, Action. Moreover the digital satellite broadcasting signals of a TV satellite system are well understood by those of ordinary skill to be different then the standard cable signals of standard CATV systems. The PTO cannot merely allege that satellite TV transmissions and cable TV transmissions are equivalent and indistinguishable when one of the cited references relied upon belies this assertion. See Schindler at col. 2, lines 35- 41 describing the cable or broadcast signal of NTSC format as different from and inferior to the standard TV satellite signal.

Thirdly, Crawford does not show a TV satellite system relative to the standard satellite link of 126 in FIG. 4. See attached pages 110-114 of the Tanenbaum text (COMPUTER NETWORKS) explaining standard use of communication satellites as data links. Not every communication satellite is a TV satellite.

Furthermore, even assuming that 134 could be used to link to a satellite TV network instead of a cable TV network, the link established would be no different than the other links in the various layers disclosed as to FIG. 4 in terms of being for DATA transmissions from the

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on-line system 100 to any of the customer computers 50 via all the layers of the DATA link 150.

See col. 16, lines 30-43 and reference numeral 150 and its bracket on the right side of FIG. 4 of Crawford. In this respect, the concern is the overall link to on-line system 150 where only one small segment will carry TV signals from a source other than the data source 100, with no hint in Crawford of modifying the standard computer 50 of FIG. 3 (or those of FIG 4) to actually tune to any particular one of a plurality of broadcast TV channels and/or to demodulate that tuned TV broadcast channel.

This added TV tuning and demodulating structure is not inherently available on computers and is a teaching arising from the PTO and not a teaching to be found in Crawford.

This improper creation of reference teachings by the PTO was considered and dismissed as being improper by the PTO reviewing court in In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) as follows:

While the court appreciates the Commissioner's thorough explanation of the claimed relationship in his brief, the Commissioner's brief is not prior art. The prior art is [the reference relied upon], and it does not indicate that the relationship is well known in the art nor does it suggest the claimed relationship.

Accordingly, the PTO cannot assume that "a satellite link" is the same thing as a TV satellite link and that all computers configured like the suggested customer computers 50 of Crawford (illustrated in FIG. 3) are capable of tuning in different TV broadcast channels and demodulating such a tuned channel to provide a TV signal to a display. As the court in Rijckaert noted, at 28 USPQ2d 1956, "the examiner's assumptions do not constitute the disclosure of prior art." Without proper prior art evidence, the initial burden of presenting a *prima facie* case of obviousness has not been met.

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Thus, if the PTO is to continue to urge that Crawford teaches the cable TV connect 134 should or can be replaced by a TV satellite link instead of the actually suggested satellite link (like illustrated link 126), and that customer computer 50(Z) is taught by Crawford to be configured to be able to receive any kind of television broadcast signal and then to supply TV program data corresponding to this received television broadcast signal to a display device, it is called upon to indicate where these teachings are to be found in Crawford as further dictated by the Court in Rijckaert at 28 USPQ2d 1957 (“when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference.”).

As the PTO has not established that such reasonable teachings are present in Crawford as to the customer computer 50 (Z) taught therein, the reliance upon Crawford as teaching the set top box (STB) of independent base Claims 1, 9, 14, 19, and 23 (and the claims dependent thereon) is clearly without merit and the rejection of Claims 1-32 as being obvious over Crawford in view of Schindler is improper and should be withdrawn for this reason alone.

Moreover, independent base Claims 1, 9, 14, 19, and 23 (and the claims dependent thereon) require, *inter alia*, a digital communication line that is external to each of the STB, a display device, and a game executing device **that interconnects these devices to form a game machine system.**

In this regard, while display device 54 of Crawford is taught to display images, and mouse 58 and keyboard 56 are taught as standard computer peripherals, there is no teaching or suggestion in Crawford that data link 150 is used in any way to interconnect any of 54, 56, or 58 to the main processor unit 52 housing the hard drive. In accordance with In re Rijckaert, *supra*,

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the PTO is called upon to state where the relied upon interconnection of 52, 54, 56, and 58 by 150 can be found in Crawford. Note further the dictates of In re Lee, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) as to the obligation of “the agency to make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency’s reasoning in reaching its conclusions” (emphasis added, citation omitted).

In addition to the above, and as noted in the last response, the outstanding Action again inappropriately attempts to lift the description of the prior art at column 2, lines 15 and 16 and transpose it into the disclosure of the Crawford system of Figs. 1 and 3 without any statement by Crawford that the download of new video games provided by the noted information providers is to be incorporated into the improved and different on-line service that Crawford proposes. The Crawford teaching is of a system for “executing host based software on the remote user’s system directly or for a user’s locally executing application to directly access storage on the host system,” see col. 7, lines 56-60, with no mention that the downloading of video games is to be included in the Crawford system to be found here or elsewhere in Crawford. As noted in In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000), “... a rejection cannot be predicated on the mere identification in [one reference] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”

Further in this last regard, the question is of “obviousness” under 35 U.S.C. §103 of adding the downloading of new video as noted relative to previous service providers to the

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Crawford taught system. As noted by the court in In re Rouffet, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

Thus, merely noting that something was known does not supply the required showing as to motivation for making a modification to the invention disclosed by the reference and the PTO must demonstrate how the Crawford teaching that it was previously known to include video game downloading would have led the artisan to modify the Crawford system, where the mere mention of a video game downloading service as a previously provided service is still not seen to be a teaching that this service is to be included in the system proposed by Crawford.

Also, to whatever extent that column 3, lines 6-21 of Schindler teaches a "set box top" device with an integrated receiver/decoder function for receiving satellite signals to standard TV signals, this is not what relied upon device 118 is. Instead, 118 is described as a personal computer or other processing circuitry that will replace such a set top box and numerous other devices if properly programmed to do so. See column 7, line 58-column 8, 18, for example.

Moreover, the artisan would not be reasonably led by the teachings of Schindler to modify Crawford because to do so would destroy the basic operation flexibility of the Crawford invention in terms of its versatile data link 150 not limited to just the TV satellite source that is

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taught by Schindler. Any proposed modification that would change the basic operating principle of a reference is not an obvious one. See In re Ratti, 123 USPQ 349, 352 (CCPA 1959). Moreover, reference modifications that would render a reference unsatisfactory for its intended purpose are also not obvious. See In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Furthermore, even if the artisan had some valid reason, a reason not set forth in the outstanding action, to attempt to modify the Crawford system to be a satellite only system as taught by Schindler, the result would still not establish a valid *prima facie* case of obviousness because neither Crawford nor Schindler teach or suggest the above-noted STB device, display device, and the game executing device being connected to each other to form the game machine system via a digital communication line that is external to each of the STB device, the display device, and the game executing device.

As Claims 3-8, 10-13, 15-18, 20-22, and 24-32 depend ultimately from one or the other of independent base Claims 1, 9, 14, 19, and 23, they include the above-noted limitations of these independent claims that are clearly not taught or suggested by Crawford. In addition, these dependent Claims 3-8, 10-13, 15-18, 20-22, and 24-32 all include additional recitations that are not taught or suggested by Crawford and, accordingly, cannot be said to be anticipated by Crawford for this reason as well.

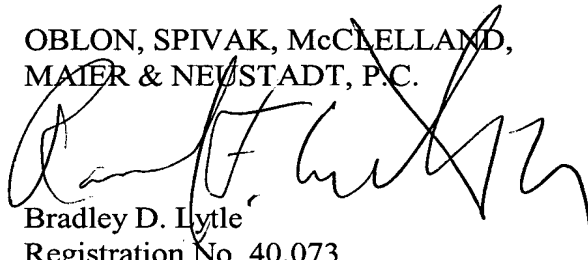
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Accordingly, as no other objections or rejections remain outstanding, it is believed that this application is clearly in condition for formal allowance and an early and favorable action to this effect is, therefore, respectfully requested.

Respectfully submitted,

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